

REMARKS

A. Cancelled Claims

Claims 1-208 are cancelled without prejudice, waiver, or disclaimer. Therefore, rejections related to any of claims 1-208 are rendered moot, and Applicants should not be presumed to agree with any statements made by the Examiner regarding claims 1-208 unless otherwise specifically indicated by Applicants.

B. Official Notice in Office Action

The Examiner has taken Official Notice that “any television program guide system ... that has a capability of tracking or monitoring the user's viewing habits must include an artificial intelligence technology therein.” According to MPEP 2144.03, “The Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge.” Applicants respectfully traverse the Examiner’s Official Notice and submit as evidence against a finding of well-known art that the Examiner has not provided specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge.

C. New Claims

Claim 209-238 have been newly added. The newly added claims 209-238 are adequately supported by the specification. Consideration of new claims 209-238 is respectfully requested. The references cited by the Examiner do not disclose, teach, or suggest the combination of any of the newly added claims 209-238.

Claim 209

Claim 209 is allowable for at least the reason that none of the cited references teach, suggest, or disclose “enabling a purchase of the television service responsive to receiving the request during the defined time period.” The cited reference *Arora* (U.S. Patent Application No. US 2003/0018972 A1) discloses providing a “surf list” having characteristics that are responsive to a user-selected time period (e.g., FIGS. 1 and 2). The cited reference *Ellis* (U.S. Patent No. 6275268) discloses enabling a purchase of a

television service (e.g., FIGS. 43 A-E, and 44). However, it would not be obvious to one of ordinary skill in the art to modify Arora's surf list method based on Ellis' television service purchase method to limit purchasing a television service as set forth in claim 209. The mere fact that the end solution would be desirable in hindsight is an insufficient basis for rejecting claim 209 based on *Arora* in view of *Ellis*:

"One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

"This court has made it clear, moreover, that an invention will not be denied a patent because it embodies a solution which seems simple and obvious with the benefit of hindsight." *Saf-gard Products, Inc. v. Service Parts, Inc.*, 532 F.2d 1266, 1272, 190 U.S.P.Q. 455 (9th Cir. 1976), *cert. denied*, 429 U.S. 896.

"(A) court must be careful not to declare an innovation obvious because it has become obvious through hindsight." *Roberts v. Sears, Roebuck & Co.*, 723 F.2d 1324, 1334, 221 U.S.P.Q. 504 (7th Cir. 1984).

"It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. *In re Gorman*, 933 F.2d 982, 987, 18 U.S.P.Q.2d 1885 (Fed. Cir. 1991).

"(T)here must be some reason for the combination other than the hindsight gleaned from the invention itself." *Interconnect Planning Corp. v. Feil* 774 P.2d 1132, 1143, 227 U.S.P.Q. 543 (Fed. Cir. 1985).

Claims 210-213

Claims 210-213 are allowable for at least the reason that each of claims 210-213 includes all the element/features/limitation of claim 209 from which claims 210-213 depend.

Claim 214

Claim 214 is allowable for at least the reason that none of the cited references teach, suggest, or disclose "enabling the recording of the television service responsive to receiving the request during the defined time period." *Arora* discloses providing a "surf

list” having characteristics that are responsive to a predetermined time period (e.g., FIGS. 1 and 2). *Ellis* discloses enabling recording of a television service (e.g., column 33). However, it would not be obvious to one of ordinary skill in the art to modify Arora’s surf list method based on Ellis’ television service recording method to limit recording a television service as set forth in claim 214. The mere fact that the end solution would be desirable in hindsight is an insufficient basis for rejecting claim 214 based on *Arora* in view of *Ellis* (see, for example, the case law citations provided above in connection with claim 209).

Claims 215-218

Claims 215-218 are allowable for at least the reason that each of claims 215-218 includes all the element/features/limitation of claim 214 from which claims 215-218 depend.

Claim 219

Claim 219 is allowable for at least the reason that none of the cited references teach, suggest, or disclose “preventing the television service from being provided to the user responsive to receiving the request during the defined time period.” *Arora* discloses providing a “surf list” having characteristics that are responsive to a predetermined time period (e.g., FIGS. 1 and 2). *Ellis* discloses blocking a television service (e.g., FIG. 30). However, it would not be obvious to one of ordinary skill in the art to modify Arora’s surf list method based on Ellis’ television service blocking method to limit blocking a television service as set forth in claim 219. The mere fact that the end solution would be desirable in hindsight is an insufficient basis for rejecting claim 219 based on *Arora* in view of *Ellis* (see, for example, the case law citations provided above in connection with claim 209).

Claims 220-223

Claims 220-223 are allowable for at least the reason that each of claims 220-223 includes all the element/features/limitation of claim 219 from which claims 220-223 depend.

Claim 224

Claim 224 is allowable for at least the reason that none of the cited references teach, suggest, or disclose “enable a purchase of the television service responsive to receiving the request during the defined time period.” *Arora* discloses a system for providing a “surf list” having characteristics that are responsive to a predetermined time period (e.g., FIGS. 1 and 2). *Ellis* discloses a system for enabling a purchase of a television service (e.g., FIGS. 43 A-E, and 44). However, it would not be obvious to one of ordinary skill in the art to modify Arora’s surf list system based on Ellis’ television service purchase system to provide a system configured to limit purchasing a television service as set forth in claim 224. The mere fact that the end solution would be desirable in hindsight is an insufficient basis for rejecting claim 224 based on *Arora* in view of *Ellis* (see, for example, the case law citations provided above in connection with claim 209).

Claims 225-228

Claims 225-228 are allowable for at least the reason that each of claims 225-228 includes all the element/features/limitation of claim 224 from which claims 225-228 depend.

Claim 229

Claim 229 is allowable for at least the reason that none of the cited references teach, suggest, or disclose “enable the recording of the television service responsive to receiving the request during the defined time period.” *Arora* discloses a system for providing a “surf list” having characteristics that are responsive to a predetermined time period (e.g., FIGS. 1 and 2). *Ellis* discloses a system for enabling recording of a television service (e.g., column 33). However, it would not be obvious to one of ordinary skill in the art to modify Arora’s surf list system based on Ellis’ television service recording system to provide a system configured to limit the recording of a television service as set forth in claim 229. The mere fact that the end solution would be desirable in hindsight is an insufficient basis for rejecting claim 229 based on *Arora* in view of *Ellis* (see, for example, the case law citations provided above in connection with claim 209).

Claims 230-233

Claims 230-233 are allowable for at least the reason that each of claims 230-233 includes all the element/features/limitation of claim 229 from which claims 230-233 depend.

Claim 234

Claim 234 is allowable for at least the reason that none of the cited references teach, suggest, or disclose “prevent the television service from being provided to the user responsive to receiving the request during the defined time period.” *Arora* discloses a system for providing a “surf list” having characteristics that are responsive to a predetermined time period (e.g., FIGS. 1 and 2). *Ellis* discloses a system for blocking a television service (e.g., FIG. 30). However, it would not be obvious to one of ordinary skill in the art to modify Arora’s surf list system based on Ellis’ television service blocking system to provide a system configured to limit blocking a television service as set forth in claim 234. The mere fact that the end solution would be desirable in hindsight is an insufficient basis for rejecting claim 234 based on *Arora* in view of *Ellis* (see, for example, the case law citations provided above in connection with claim 209).

Claims 235-238

Claims 235-238 are allowable for at least the reason that each of claims 235-238 includes all the element/features/limitation of claim 234 from which claims 235-238 depend.

CONCLUSION

Applicants respectfully maintain that the currently pending claims 209-238 are in condition for allowance. Should the Examiner have any comments or suggestions that would place the subject patent application in better condition for allowance, he is respectfully requested to telephone the undersigned attorney at (770) 933-9500.

**THOMAS, KAYDEN, HORSTEMEYER
& RISLEY, L.L.P.**

Sami O. Malas

Sami O. Malas; Reg. No. 44,893
Attorney for Applicant

Thomas, Kayden, Horstemeyer & Risley, LLP
100 Galleria Parkway, NW
Atlanta, GA 30339
Ph: (770) 933 - 9500
Fax: (770) 951 – 0933